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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/532,235 | 03/22/2000 | Masahiro Ishigami | 13478 | 8479 |

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| EXAMINER |
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LELE, TANMAY S

| ART UNIT | PAPER NUMBER |
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2684

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DATE MAILED: 11/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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Advisory Action

Application No.

09/532,235

Applicant(s)

ISHIGAMI, MASAHIRO

Examiner

Tanmay S Lele

Art Unit

2684

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: (see attached response).

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 9-15, 17, 19 and 20.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.

Tanmay Lele
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Response to Arguments

1. Applicant's arguments filed 20 October 2003 have been fully considered but they are not persuasive.

2. In response to applicant's argument that "[Moon] does not disclose –said processing corresponding to a single click or a double click of a mouse", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Regarding claim 12, Applicant attempts to overcome the rejection by citing the differences in the court case and case at hand and further that, "... a mouse of a computer can perform several different functions, such as highlighting or scrolling, neither of which corresponds to a single click or double click of a mouse," and "Furthermore, a processor performing processing corresponding to a single click or double click of a mouse must, by necessity, entail a structural difference in the processor and not the method." Moon's teachings, as cited in the previous Office Action (paper 9, pages 2 –3) are respectfully believed to read on the Applicant's claimed language, as presently presented. Note that though Applicant states "... a mouse of a computer can perform several different functions, such as highlighting or scrolling, neither of which corresponds to a single click or double click of a mouse," the noted section of Moon do not relate to such a concept (as the claimed language did not recite such). As cited,

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Moon was believed to cure the cited, "...processing corresponding to a single click or double click of a mouse" (paper number 9, pages 4 –5). Note further the passage (Figure 7 and column 7, lines 42 – 65) as fully detailed in the previous Office Action (paper number 9, pages 2 – 3) icons are added as per Moon's invention, the steps corresponding (or having in the same relationship as in position by definition from Merriam-Webster's 10th Edition Dictionary) to the function of a mouse. In regards to the appropriateness of the *In re Otto* and *In re Case*, Examiner contends that the cited case law, when viewed as whole, are appropriate. Note that Applicant states, "...It will be seen It will be seen that the Lampert case pertains to the impropriety of relying on a method concept to distinguish a structural claim over the prior art and Rishoi and the others indicate that inclusion of the material or article worked upon by a structure being claimed does not impart patentability to the claims." Examiner respectfully does not understand Applicant's intent, as the entire paragraph reads, "First of all it should be remembered that the claims are directed to a particular device and a method of making that device, not to a method of curling hair wherein this particular device is used. It seems appellants are endeavoring to predicate patentability upon a certain procedure for curling hair using this device and involving a number of steps in the process. This process is irrelevant as is the recitation involving the hair being wound around the core insofar as the determination of whether these particular claims should be allowed or rejected. *In re Lampert et al.*, 44 CCPA 958, 245 F.2d 253, 114 USPQ 163; *In re Rishoi et al.*, 39 CCPA 1004, 197 F.2d 342, 94 USPQ 71; *In re Mulholland*, 29 CCPA 1222, 129 F.2d 860, 54 USPQ 388; *In re Young*, 22 CCPA 1060, 75 F.2d 996, 25 USPQ 69," where it could be assumed that the argument for this case would be in regards to the function of a mouse (analogous to *In re Otto*'s curling hair). If such were assumed to be the argument, the

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cited would only support Examiner's position, from the above quoted decision. Accordingly, the Examiner is still not persuaded by the Applicant's argument that the references, when combined for the cited motivation, do not teach, recite, or suggest the features disclosed.

In regards to claim 17, as cited in the previous Office Action, (paper number 9, page 3) "...the claim read (and still currently reads after amending) '*at least one of*' would indicate only one of the claimed need be met. The cited passage from the previous Office Action (paper 6, pages 12 and 13) met at least the 'Japanese kana' (evidenced through the passage, an example being column 28, line 61)." Accordingly, the Examiner is still not persuaded by the Applicant's argument that the references, when combined for the cited motivation, do not teach, recite, or suggest the features disclosed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tanmay S Lele whose telephone number is (703) 305-3462. The examiner can normally be reached on 9 - 6:30 PM Monday – Thursdays and on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay A. Maung can be reached on (703) 308-7745. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

✓
Tanmay S Lele
Examiner
Art Unit 2684


NAY MAUNG
SUPERVISORY PATENT EXAMINER

tsl
November 12, 2003